

Appl. No. 09/991,530
Atty Docket No. 1205-011/JRD
Amendment Dated Nov. 10, 2004
Reply to Office Action of May 10, 2004

REMARKS

A non-final Office Action, dated May 10, 2004, rejects pending claims 1-20. Claims 6 & 13 have been amended herein. Reconsideration is respectfully requested in of the foregoing amendments and the following remarks.

35 USC § 112 (Second Paragraph)

Applicants have amended claims 6 and 13 where indicated to make the "National Drug Code" number limitation more definite. As currently amended, these claims should now satisfy 35 USC §112 (second paragraph).

35 USC § 103

Applicants respectfully traverse the examiner's rejection of claims 1-20 as somehow being rendered obvious by the references of record. The references of record are either missing essential elements, or they are missing a teaching or suggestion to combine them as currently claimed.

"Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so . . ." [MPEP § 2143.01]. Applicants traverse the examiner's rejections of these claims on at least the following grounds:

1. There is no teaching to use a wireless identification tag with read-writable memory in a retail pharmacy as currently claimed.

Applicants respectfully traverse the examiner's comment that the references of record teach or suggest using a wireless identification tag with read-writable memory in a pharmacy to automatically detect a prescription order and extract information about that prescription order.

The issue of pharmacies distributing incorrect prescription orders to customers has been around for a long period of time. For example, a scene in the classic 1946 film "It's A Wonderful Life" focuses on the main character, George Bailey, correcting a mistake of the pharmacist that would have resulted in a customer receiving the wrong prescription order.

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Yet, despite this long felt need to correct this problem and the prior attempts of others to correct it, even today many customers are still inadvertently being given the wrong prescription orders. For example, a jury recently awarded a customer of Wal-Mart Stores, Inc. over \$800,000 in damages for accidentally giving that customer the filled prescription order of another customer who had the same last name.

U.S. Patent No. 6,464,142 to Denenberg et al. ("Denenberg") teaches having a pharmacy worker manually scan the bar code on a filled prescription and having the computer system instruct the pharmacy worker where to place that filled prescription order in a storage area. No information about the prescription order is provided on the bar code label. Accordingly, much like the pharmacist in "It's A Wonderful Life," the Denenberg system still relies on the pharmacy worker to perform affirmative acts, namely scan the filled prescription and correctly enter information about the filled prescription into the computer system, before the Denenberg tracking system to be effective.

While U.S. Patent No. 6,496,806 to Horwitz et al. discloses using read/write tags to store a pallet ID therein, there is no teaching or suggestion to use these types of tags in a pharmacy for purposes of reducing pharmacy worker errors. Since the references neither teach nor suggest the combination of elements as currently claimed in independent claim 1, this claim cannot be rendered obvious. Accordingly, claim 1 should be in condition for allowance. Moreover, since dependent claims 2-9 depend allowable claim 1, they too should now be in condition for allowance.

2. There is no teaching to use a wireless tag reader capable of simultaneously reading a plurality of different wireless tags in a pharmacy.

Applicants respectfully traverse the examiner's rejection of claim 10. Claim 10 specifically requires in a pharmacy a "first tag reader able to simultaneously detect the presence of said plurality of tags when said plurality of tags is in close proximity of said first tag reader and send a first signal to said computer system." No references of record teach or suggest such a structure. Accordingly, claim 10 and claims 11-20, which depend on it, should be in condition for allowance.

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Atty Docket No. 1205-011/JRD
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3. There is no teaching to activate a transducer on a wireless tag to alert a pharmacy worker.

"It is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based." MPEP Sec. 2144.03(A). Applicants respectfully traverse the examiner's statements that activating a transducer on a wireless tag would have been obvious to one of ordinary skill in the art. (May 10, 2004 Office Action, Page 3, lines 18-21).

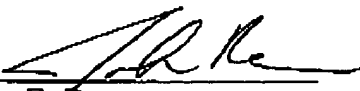
As previously discussed, no references of record teach or suggest using wireless tags in a retail pharmacy as currently claimed. Moreover, even if there were such a teaching, none of the references of record teach or suggest activating a transducer on such wireless tag in a pharmacy environment to reduce pharmacy worker dispensing errors and the like. Accordingly, claim 7 is also patentable on these grounds.

In view of the foregoing, applicants submit that all of the currently pending claims are in condition for allowance, and respectfully request that the case be passed to issuance. If the Examiner has any questions, he is invited to contact applicants' attorney at the below-listed telephone number.

Respectfully submitted,

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